

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

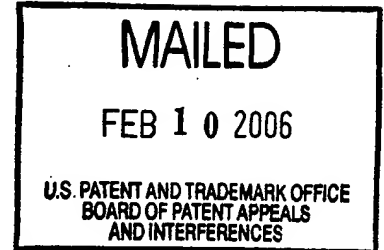
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHEILA RENEE CROSBY, STEVEN TODD BARLOW,
and ROBERT JOHN STRONG

Appeal No. 2006-0372
Application No. 09/486,545

ON BRIEF



Before KRASS, GROSS, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-14, which are all of the claims pending in this application.

We AFFIRM-IN-PART and enter a NEW GROUND OF REJECTION under 37 CFR § 41.50(b).

BACKGROUND

The appellants' invention relates to a system and method for navigating within a display having different sections (specification, page 1).

Claim 1 is representative of the invention, and is reproduced as follows:

1. A system for navigating within a display having one or more display sections, comprising:

means for selecting a first section of said display;

means for navigating within said first section of said display;

control means for displaying a navigational symbol on a border of said first selected section, said symbol corresponding to a direction in which a highlight may be moved; and

said control means moves said highlight to a second section of said display in said corresponding direction in response to the steps of highlighting said navigational symbol on said border of said first selected section and selecting said navigational symbol.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Rowe et al. (Rowe)	5,812,123	Sep. 22, 1998
Montalbano	5,918,237	Jun. 29, 1999

Claims 1-3 and 5-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rowe.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rowe in view of Montalbano.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed June 3, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed March 14, 2005) for the appellants' argument thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Argument which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' argument set forth in the briefs along with the

examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 1-3 and 5-14 under 35 U.S.C. § 103(a) as being unpatentable over Rowe. We turn first to claim 1.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed.

Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, page 4) is that in Rowe each program title 66 or 66' contains information icons which can be selected by the user, but that Rowe does not clearly show navigating within the first section. The examiner asserts (id.) that "[i]t is well known and would have been obvious to modify the program tiles to provide more selecting information such as links, audio files, images, and etc. to give the user more detail about the current program."

Appellants' position (brief, page 5) is that the cited reference fails to teach or suggest all of the limitations of

claim 1. It is argued (brief, page 6) that Rowe does not teach or remotely suggest a means for navigating within said first section of the display. It is further argued (id.) that "[t]he examiner has been unable to provide a reference that teaches the limitation of moving a highlight to a second section of said display in said corresponding direction in response to the steps of highlighting said navigational symbol on said border of said first selected section and selecting said navigational symbol." In addition, appellants assert (brief, page 7) that the examiner has been unable to provide a reference that teaches the limitation of "means for navigating within said first section of said display," and that if Rowe were modified to include more information within the focus frame, the user would be unable to navigate within the focus frame since Rowe teaches that pushing the navigational controls on the remote control moves the focus frame to the adjacent section of the display.

From our review of Rowe, we find that as noted by the examiner (answer, page 4), Rowe discloses that each program tile contains information icons. Specifically, we find that Rowe discloses (col. 16, line 59 through col. 17, line 10) that:

Each program tile 66' represents information about a selected program and can display the program title or name, and the channel number. Each program tile 66'

also include the network name and the network symbol, which is typically implemented as an icon graphically representing the logo of the corresponding channel or network. If display space is available within the limited area of the program tile, then program information of secondary interest to the user can be presented as information icons on the program tiles 66'. Information icons, which are graphical images representing secondary information items, can be used to reduce the amount of text displayed by a program tile, thereby making it easier for the subscriber to locate and read the program titles. Information icons can represent a variety of secondary program-related information, including the items of closed captioning, audience rating, awards, star rating.[sic] or reruns status. It will be understood that the use of information icons is an option for the user interface supplied by the program schedule 50'.

From the disclosure of Rowe, we find that if space is available, program information of secondary interest to the user can be presented as information icons on the program tiles 66'. It is disclosed that the graphical images representing secondary information can be used to reduce the amount of text displayed by a program tile for the subscriber to locate and read. Icons can represent closed captioning, audience rating, awards, star rating or reruns status. From the disclosure that the icons are read by the user, we find no teaching or suggestion that the icons are clickable by the user, but rather are simply read to provide the secondary information; see also col. 4, lines 20-22.

Accordingly, we do not agree with the examiner (answer, page 4) that these icons are selectable by the user, but rather are like the network symbols, which are also referred to as icons (col. 16, lines 61-64). From the above, we find that Rowe does not disclose or suggest making the icons within program tiles selectable, as Rowe does not disclose navigating within a section of the display, as recited in claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Rowe is reversed.

We also reverse the rejection of independent claims 7 and 13 because Rowe does not select icons within a section of the display screen, as Rowe selects category, subcategory and program tiles, rather than icons within a section of the display. As claims 2, 3, 5, 6, 8 and 14 depend from independent claims 1, 7 or 13, the rejection of claims 2, 3, 5, 6, 8 and 14 under 35 U.S.C. § 103(a) is reversed.

Turning to independent claim 9, we observe that claim 9 does not recite navigating within a section of the display. Nor does the claim recite selecting of icons. In fact, the claim does not recite icons at all. From our review of Rowe, we find that Rowe discloses navigating within a display 50 (figure 3) having a

plurality of display sections 52, 54, and 56. As shown in figure 3, upon moving focus frame 60 to subcategory tile 64, representing basketball, the selection of subcategory tile 64 results in navigational arrow tab 67 being provided on a border of the selected section or tile. Navigational arrow tabs 67 correspond to a navigable direction of a highlight (col. 8, lines 39-41 and col. 10, lines 58-64). By moving navigational key 70a, for example, the selected subcategory will be changed. Since the selection of subcategory 64 will result in the selected area being highlighted, causing the arrow tabs 67 to appear, the subsequent movement of navigation key 70a will result in the selected subcategory appearing within the focus frame 60.

We are not persuaded by appellants' assertion (brief, page 9) that Rowe does not teach navigating within a display having one or more display sections in response to the steps of highlighting a navigational symbol and selecting the navigational symbol. In Rowe, upon moving the focus frame to subcategory 64, the arrow tabs 67 will be displayed and the focus frame will be highlighted. By moving navigation key 70a, the subcategory displayed will scroll in the direction of the navigation arrow tab selected, so that the selected subcategory will be displayed in the focus frame. Thus, we find that Rowe discloses the

language of claim 9. Accordingly, the rejection of claim 9 under 35 U.S.C. § 103(a) is affirmed. As claims 10 and 12 have not been separately argued, they fall with claim 9 from which they depend. Accordingly, the rejection of claims 10 and 12 under 35 U.S.C. § 103(a) is affirmed.

Turning to claim 11, appellants assert (brief, page 10) that it is impossible in Rowe for the control means to move the highlight to another icon within the selected icon. From our review of claim 11, we find that the claim lacks antecedent basis for the term icon, since the reference to "another icon in said selected section" implies that there is already an icon within the selected section. In our view, the language of claim 11 may imply more than one icon within a single section of the display, or an icon in addition to the navigational symbol with the navigational symbol considered to be an icon, even though the navigational symbol is not referred to as an icon in the claim. Thus the scope and content of the claim cannot be readily ascertained.

While we might speculate as to what is meant by the claim language, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior

art as we are obliged to do. Rejections under 35 U.S.C. § 103 should not be based upon "considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims." In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Accordingly, we are constrained to reverse, pro forma, the examiner's rejection of claim 11 under 35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the section 103 rejections.

We turn next to the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Rowe in view of Montalbano. We reverse the rejection of dependent claim 4 because Montalbano do not make up for the deficiencies of Rowe.

NEW GROUND OF REJECTION UNDER 37 CFR §41.50(b)

Claim 11 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. As set forth, supra, in our reversal of the rejection of claim 11 under 35 U.S.C. § 103(a),

we find the language of claim 11 to be indefinite because the reference to "another icon in said selected section" implies that there is already an icon within the selected section. As stated above, the language of claim 11 implies more than one icon within a single section of the display, or an icon in addition to the navigational symbol with the navigational symbol considered to be an icon, even though the navigational symbol is not referred to as an icon in the claim. Thus the scope and content of the claim cannot be readily ascertained, rendering the claim indefinite within the meaning of 35 U.S.C. § 112, second paragraph.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence

relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8, 11, 13 and 14 under 35 U.S.C. § 103 is reversed. The decision of the examiner to reject claims 9, 10 and 12 under 35 U.S.C. § 103(a) is affirmed. In addition, we have entered a new ground of rejection against claim 11 as being indefinite within the meaning of 35 U.S.C. § 112, second paragraph.

AFFIRMED-IN-PART and NEW GROUND OF REJECTION
UNDER 37 CFR § 41.50(b)

ERROL A. KRASS
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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